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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,744	12/05/2003	Dae Sung Kim	1347.07	7199

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PARK & SUTTON LLP
3255 WILSHIRE BLVD
SUITE 1110
LOS ANGELES, CA 90010

EXAMINER

PICKETT, JOHN G

ART UNIT PAPER NUMBER

3728

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/727,744

Applicant(s)

KIM ET AL.

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/5/03 & 7/19/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the substantially circular protrusions of claims 6 and 13 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 2, 8, and 9, the phrase "and other items" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "and other items"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). The examiner questions how the mid portion of the post, as disclosed by the applicant, prevents tangling of items such as small rubber bands or paper clips.

Further regarding claims 2 and 9, it is unclear as to whether the protrusion structures following the functional "wherein" statement are included in the holder since there is no action verb, with respect to the protrusions, within the claim language. To prosecute the examination of the claims, the examiner assumes the protrusion structures to be included in the holder.

Claims 3-6 (dependent upon claim 2), claim 7 (dependent upon claim 1), and claims 10-13 (dependent upon claim 9) are rejected for the above reasons.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Cripe (US 4,289,249).

Claims 1 and 8: insofar as the examiner can determine the scope of the claim, Cripe discloses a multi-purpose holder **10** comprising a container **11** with a base **32** having a peripheral wall **31** extending upwards from the outer circumference of base **32**, and a post **27** attached to base **32** (Col. 2, lines 38-42) with a top end holding a decoration article (spherical item on top of post **27**). Post **27** itself, is inherently capable of functioning as a decoration article, as recited in claim 8. Cripe is inherently capable of tangle prevention as claimed and further discloses a peripheral wall height of 2 inches (Col. 3, lines 12-14).

Claims 2, 3, 9, and 10: Cripe discloses radial protrusions **13-19** along an upper rim of peripheral wall **31**.

Claim 7: post **27** of Cripe serves as a handle (Col. 2, lines 38-42).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1, 2, 5, 8, 9, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeCoster (Des. 389,011).

DeCoster discloses a holder as shown below:

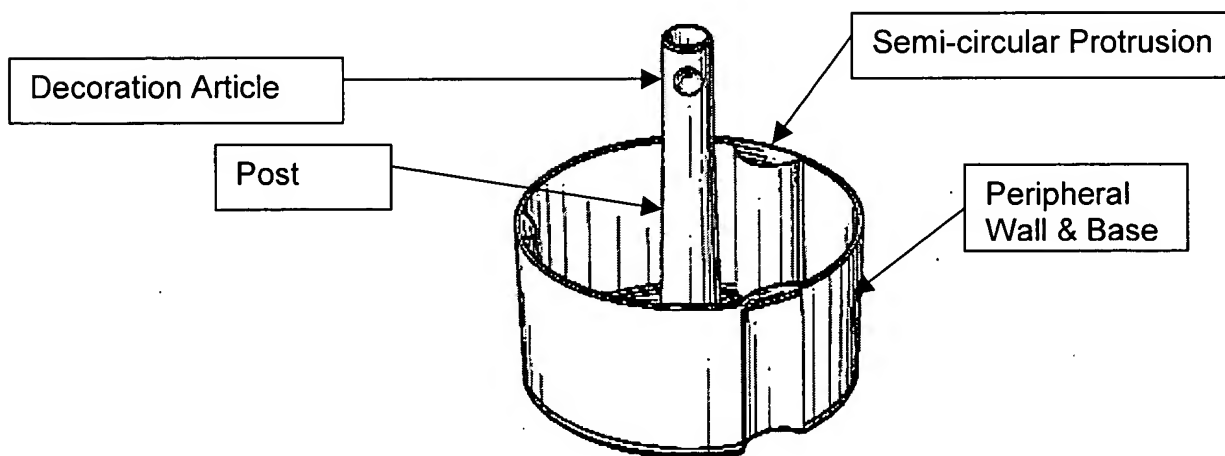
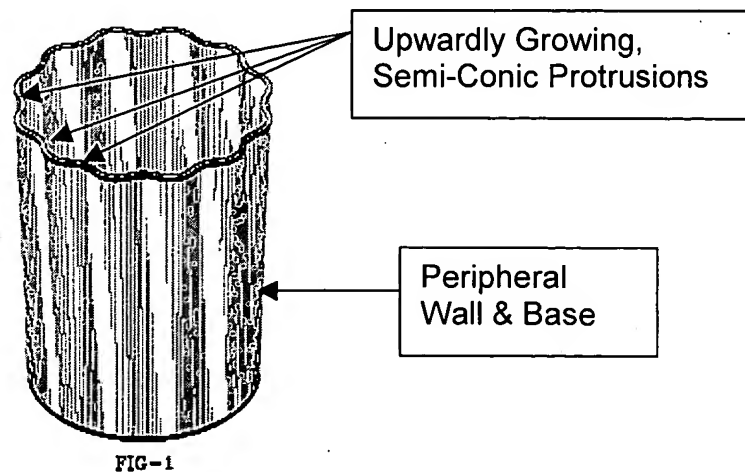


FIG. 1

DeCoster is inherently capable of functioning as claimed. DeCoster merely lacks the express disclosure of a peripheral wall height of at least two inches. DeCoster is designed to retain food, and it would have been readily apparent to one of ordinary skill in the art that an increase in wall height would result in a greater storage volume. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the peripheral wall of DeCoster with a height of at least two inches in order to retain a larger volume of food. Such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

5. Claims 1, 2, 4, 8, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hampshire (Des. 417,936) in view of Toshihiro (JP 2001-150869 A; provided by applicant).

Hampshire discloses a holder as shown below:



Hampshire merely lacks the express disclosure of a height of at least two inches and a post attached to the base.

As to the height, it would have been readily apparent to one of ordinary skill in the art that an increase in wall height would result in a greater storage volume. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the peripheral wall of Hampshire with a height of at least two inches in order to retain a larger volume of articles. Such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

As to the post, Toshihiro discloses a post **15** with a decoration article **17** attached to the base of housing **2**. The examiner considers the post attached since post **15** is held fast by gravity and the interaction of support **18** with the housing sidewall **3**. Toshihiro teaches the post for use in pulling-up the retained matter (see English Abstract, provided by applicant). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the housing of Hampshire with the base-post-decoration article of Toshihiro in order to pull up any articles retained, thereby facilitating article removal.

6. Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGinnis (US 5,002,182) in view of Baxter (US 2001/0050499 A1).

Insofar as the examiner can determine the scope of the claim, McGinnis discloses a multi-purpose holder (Figures 1-8) comprising a container **10** with a base

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having a peripheral wall extending upwards from the outer circumference of base (as shown, Figures 2 and 4), and a post **18** attached to the base (at **20**) with a top end holding a decoration article **12** (see for example, Figure 5). Post **18** itself, is inherently capable of functioning as a decoration article, as recited in claim 8. McGinnis is inherently capable of tangle prevention as claimed.

McGinnis retains crayons **14** and merely lacks the explicit teaching of a height of at least two inches.

Baxter discloses that the standard crayon lengths are 3.5 inches. As McGinnis is shown to fully enclose the crayon **14**, it would have been obvious to one of ordinary skill in the art to make the peripheral wall at least 3.5 inches.

7. Claims 2, 6, 9, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGinnis-Baxter as applied to claims 1 and 8 above, and further in view of Chang (Des. 401,971).

McGinnis-Baxter discloses the claimed invention except for the substantially circular, radial protrusions.

Chang discloses substantially circular, radial protrusions (see Figures 1 and 3). One of ordinary skill in the art would have recognized from Chang that articles retained within the protrusions would be firmly retained in place, thereby limiting movement during transport. See MPEP § 2125. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the holder of

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McGinnis-Baxter with substantially circular, radial protrusions as taught by Chang, in order to limit movement of the retained articles during transport.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Greg Pickett
Examiner
14 September 2005


Mickey Yu
Supervisory Patent Examiner
Group 3700